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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/988,291  | 11/19/2001  | Michael J. Rothman   | 47004.000180        | 8456             |
| 21967   | 7590        | 05/10/2004           | EXAMINER            |                  |
| HUNTON & WILLIAMS LLP<br>INTELLECTUAL PROPERTY DEPARTMENT<br>1900 K STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20006-1109 |             |                      | AKERS, GEOFFREY R   |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 3625                 |                     |                  |
| DATE MAILED: 05/10/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|   |              |  |
|---|--------------|--|
| Application No.   | Applicant(s) |  |
| 09/88291  | Rothman      |  |
| Examiner  | Art Unit     |  |
| Akers, G  | 2635         |  |
| -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- |              |  |

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 3/24/04

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 59-61, 63-75, 77-87, 99-118, 87-97 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 59-61, 63-75, 77-87, 99-118, 87-97 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1. This action is issued in reply to applicant's Amendment E(Paper #16) filed 3/25/04.
2. New claims 107-118 were added.
3. Claims 59-61,63-75,77-87,89-97,99-118 including newly added claims, are pending.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 59-61,63-75,77-87,89-97,99-118 including newly added claims, are rejected under Deaton(US Pat. No: 6,424,949) in view of Kramer(US Pat. No: 6,327,574) in view of Eldering(US Pat. No: 6,298,348)and further in view of Hendrick(US Pat. No: 6,377,936).

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6. As per amended claims 59-61,62-75,77-87,89-97,99-118 Deaton teaches a computer system for storing and manipulating merchant level customer purchase information received from a plurality of sources including a terminal(Abstract)(Fig 2A)(Fig 4A-1/4)(Fig 14A)(Fig 15B)(Fig 26)(col 4 line 62-col 5 line 27) where the computer system has a storage device for storing customer purchase information(Abstract)(Fig 2B)(Fig 3)at the merchant level (Abstract)(Fig 2A)(Fig 4A-

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1/4)(Fig 14A)(Fig 15B)(Fig 26)(col 4 line 62-col 5 line 27) consisting of receiving customer purchase information(col 4 line 51-col 5 line 43) at the merchant level (Abstract)(Fig 2A)(Fig 4A-1/4)(Fig 14A)(Fig 15B)(Fig 26)(col 4 line 62-col 5 line 27) as well as searching the customer database(Figs 14A-17A) at the merchant level (Abstract)(Fig 2A)(Fig 4A-1/4)(Fig 14A)(Fig 15B)(Fig 26)(col 4 line 62-col 5 line 27). In addition to that taught by Deaton, Kramer teaches organizing consumer attributes in a heirarchical manner(Abstract)(col 3 lines 22-33) and a match engine(Fig 10.1016/1018) and derivation of a match score metric(Fig 10/1020). Kramer also teaches transaction histories of customers(col 14 lines 12-col 15 line 22) which permits the creation of customer preferences and heirarchical models(col 20 line 53-col 22 line 15).Kramer also teaches that the heirarchical model allows recursive selection of conditional content with the initial selection of content using higher levels of aggregated attributes and subsequent selection using a combination of lower levels of attributes which the higher levels are based and consumer expression of interest in each level of selectedcontent(col 3 lines 27-33) and creation of a model consisting of a vector of data values(col 3 lines 40-60). Kramer also teaches Boolean matching(Fig 10/1016) and metric matching(Fig 10/1018) and linking by mapping(Fig 10/810) as well as Boolean query(Fig 10/1034) and a target vector(Fig 10/1036). Kramer teaches categories and subcategories of conditions by successive tree-structure branching(Figs 12A)(Fig 12B0(Fig 13A)(Fig 13B)(col 20 line 52-col 33 line 37) where Kramer teaches attribute vectors(col 21 line 61-col 23 line 3) and the selection process(col 23 line 4-col 30 line 60). Kramer further teaches where the customer purchase information comprises stored

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value information(Fig 6)(Figs 14-16)(col 30 line 60-col 33 line 38) as well as credit card transactions with merchants(col 32 lines 2-23). In addition to that taught by Kramer, Eldering further teaches product vectors which constitute categories of products(Fig 2D/253) which enables the offering of goods and services(col 7 line 20-col 8 line 42).Eldering teaches both a date and dollar descriptor(Fig 5/518/516) as well as demographic(Fig 5/548)correlation. Eldering further teaches a private network(Fig 1A/120) and operation on the Internet(Fig 1A/150).Eldering also teaches an entire customer profiling system(Fig 5) including hueristic rules(Fig 5/530) and products demographics vectors(Fig 7)(Fig 6B)(Fig 6A) and calculating product preference correlation(Fig 8B/920). In addition to that taught by Eldering, Henrick teaches forming an offer to a customer based on the customer's preferences(Abstract)(col 4 lines 21-32) as well as extending the offer through the Internet(col 4 lines 10-21).Henrick also teaches use of an e-mail sent to customers which includes a hyperlink with an embedded URL to a website of a particular advertiser for a consumer(col 1 lines 39-52). Henrick further teaches an apparatus for performing targeted marketing over a network(col 2 lines 10-26). It would have been obvious to one skilled in the art at the time of the invention to combine Deaton in view of Kramer to teach part of the disclosure. The motivation to combine is to teach a system that permits the analysis of historical consumer purchasing behavior as enunciated by Kramer(col 2 lines 38-44). Furthermore it would also have been obvious to one skilled in the art at the time of the invention to combine Deaton in view of Kramer and further in view of Eldering to teach a further part of the disclosure. The motivation to combine is to teach a system that

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permits the profiling of consumers to determine appropriate advertisements for consumers as enunciated by Eldering(col 3 lines 10-56). Finally, it would have been obvious to one skilled in the art at the time of the invention to combine Deaton in view of Kramer in view of Eldering and further in view of Henrick to teach the disclosure. The motivation to combine is to teach a system that enables merchandisers and providers of market products to consumers over a network as enunciated by Henrick(col 1 lines 32-35).

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims cited have been considered but are not persuasive. Applicant's sole argument is that the references do not disclose the element of "receiving merchant level customer purchase information and organizing merchant-level customer purchase information" as stated in independent claim 59 and addressed by applicant in Amendment E(p. 18). Hendrick teaches that the merchant(ISP) has a unique knowledge of a customer's preferences(Abstract). Information is gathered on customers as to the sites visited to classify the customers(Disney site) and the information is used to categorize customers for business marketing(Abstract).The server creates a list of customers that have a common interest(col 2 lines 13-15). Eldering discloses a consumer profiling system to learn about customers' preferences(Abstract) are formed based on purchases made. The purchase records are formed and sent to the profiling system by merchants(Abstract).Using a relational database product category and demographics are correlated(Fig 6B). It is clear that a relational database may also be used to

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determine merchants that sent the information to the profiling system. Eldering indeed receives point of purchase information from such merchants(Fig 8A/800)(col 12 lines 32-36). Eldering teaches receiving merchant level customer purchase information(Fig 8A/800) from every merchant. Collectively combining these point of purchase sales and classifying them by merchant defines applicant's element.

***Conclusion***

**8. THIS ACTION IS MADE FINAL.**

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9. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703)-308-3687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-1113.

GRA

May 10,2004



DR. GEOFFREY R. AKERS, P.E.  
PRIMARY EXAMINER